



**UNITED STATES DEPARTMENT OF COMMERCE  
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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER

WALKE, A

ART UNIT

PAPER NUMBER

1752

DATE MAILED: 04/12/00

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Applicant(s)

Applicant(s)

89/374989

Katana

Examiner

A. Walker

Group Art Unit

1752

—The MAILING DATE of this communication appears on the cover sheet beneath the correspondence address—

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, such period shall, by default, expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).

## Status

- ☒ Responsive to communication(s) filed on 8/16/99
- ☐ This action is FINAL.
- ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

## Disposition of Claims

- ☒ Claim(s) 1-5 is/are pending in the application.
- Of the above claim(s) 6-8 is/are withdrawn from consideration.
- ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- ☒ Claim(s) 1-5 is/are rejected.
- ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- ☐ Claim(s) \_\_\_\_\_ are subject to restriction or election requirement.

## Application Papers

- ☒ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- ☐ The proposed drawing correction, filed on \_\_\_\_\_ is ☐ approved ☐ disapproved.
- ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- ☐ The specification is objected to by the Examiner.
- ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119 (a)-(d)

- ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- ☒ All ☐ Some\* ☐ None of the CERTIFIED copies of the priority documents have been received.
- ☐ received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- ☐ received in this national stage application from the International Bureau (PCT Rule 1.7.2(a)).

\*Certified copies not received: \_\_\_\_\_

## Attachment(s)

- ☐ Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- ☒ Notice of Reference(s) Cited, PTO-892
- ☒ Notice of Draftsperson's Patent Drawing Review, PTO-948
- ☐ Interview Summary, PTO-413
- ☐ Notice of Informal Patent Application, PTO-152
- ☐ Other \_\_\_\_\_

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## DETAILED ACTION

### *Election/Restriction*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-5, drawn to a photographic material, classified in class 430, subclass 396.
  - II. Claims 6-8, drawn to a photographic printing system, classified in class 396, subclass 155 .
2. The inventions are distinct, each from the other because of the following reasons:

Inventions Group I and Group II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are not related because the photographic printing system of Group II is not needed to carry out the print processing of the material. The developed photographic material of Group I may be print processed using another system which may or may not have means to read the identification code.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

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4. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Marc Weiner on 4/4/2000 a provisional election was made without traverse to prosecute the invention of Group I, claims 1-5. Affirmation of this election must be made by applicant in replying to this Office action. Claims 6-8 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

***Claim Rejections - 35 USC § 103***

6. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 1-5 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gasper et al ( 5,919,730) in view of Orengo et al (6,020,115).

Gasper et al disclose a copy restrictive material comprising a reflective or transmissive support having coated thereon at least one light sensitive image forming layer, and a pattern of visually undetectable, but machine detectable, microdots positioned between the support and the light sensitive layer ( column 3, line 13- column 4, line 5, column 6, line 5 - column 7, line 48). A

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suggested means of incorporating the microdot pattern into the material is to laminate the material using a transparent overlay containing the microdots. The microdots may be made of materials such as colorants commonly used as dyes, solid particle dyes, pigments, inks, and toners. These colorants may be transparent, translucent, or opaque, and may modulate light by any means including refraction, scattering, or emission of light. Both color and black and white image forming photographic materials are useful in the present invention ( column 9, line54- column 10, line 6). In column 9, the reference states that the photographic media suitable for use in the practice of the invention is a silver halide photographic material. The silver halide photographic material preferably contains at least one but preferably more radiation sensitive emulsion layers sensitive to a region of the spectrum extending from the ultraviolet to the infrared specifically the red, green, and blue regions. The specific order and additives may be any known in the art. The microdots may be printed onto the support of the material prior to the addition of the emulsion layers ( column 10, lines 7-50). It is the position of the examiner that the pattern of visually undetectable, but machine detectable, microdots positioned between the support and the light sensitive layer of the Gasper et al reference is an identification code as it identifies the material and inhibits it from being copied.

Orengo et al disclose a multilayer silver halide photographic material having on a support blue, green, and red sensitive emulsion layer units containing yellow, magenta, and cyan dye-forming couplers respectively ( column 12, lines 11-49). The most sensitive layer of each emulsion layer unit has a weight ratio of the coupler to the silver halide which is lower than or

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equal to that of the medium sensitive layer and much lower than that of the low sensitive layer. In other words, the layer of highest sensitivity of the emulsion layer unit is "starved" of dye-forming coupler. The couplers used in the green sensitive layers are 2-equivalent 5-pyrazolone magenta couplers which worsen the interimage effect (column 4, lines 38-68). An improvement in the interimage effect may be achieved by making higher the coupler/ silver ratio in the highest sensitive layer of the green emulsion layer unit. Other than the dye-forming couplers, the emulsion layers may contain masking couplers and DIR couplers (column 13 line 56- column 14, line 45 and column 23 lines 59-68 also see example 1). The support of the material may be a cellulose ester support, paper support, or a polyester film support (column 24, lines 48-54).

It would have been obvious to one of ordinary skill in the art to prepare a copy restrictive document as taught by Gasper et al choosing to use the known silver halide photographic material of Orengo et al which has an interimage effect, contains masking couplers, and DIR couplers, with reasonable expectation for achieving a copy restrictive photographic material having non-visible, but machine detectable microdots of high quality and utility.

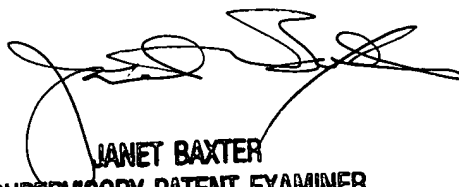
8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Amanda Walke whose telephone number is (703) 305-0407. The examiner can normally be reached on Monday- Thursday from 6:30 to 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Janet Baxter, can be reached on (703) 308-2303. The fax phone number for the organization where this application or proceeding is assigned is (703) 305-3599.

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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0661.

ACW  
acw  
April 10, 2000



JANET BAXTER  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1700